

REMARKS

By the present amendment, Applicant has amended Claims 1 and 8-10. Claims 2, 4, 11 and 13 have been cancelled. Claims 1, 3, 5-10, 12 and 14-16 remain pending in the present application. Claims 1 and 8 are independent claims.

Applicant's representative was unable to contact the Examiner to arrange a personal interview before expiration of the current period for response. Applicant herein requests a personal interview in accordance with MPEP § 713.01 to discuss the merits of the present invention and to consider the effects of the present amendment thereon. Applicant's representative will contact the Examiner in the near future to arrange a convenient date for the interview.

Claims 1, 3, 5 and 6 have been rejected by the Examiner under 35 U.S.C. § 102(e) as being anticipated by Kobylinski (US 6,883,546). Claims 8, 11, 12 and 14 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Mostala (US 6,755,216).

Claim 2 has been rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Kobylinski (US 6,883,546) in view of Mostala (US 6,755,216). Claim 4 has been rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Kobylinski (US 6,883,546) in view of Provost (US 1,616,392). Claim 7 has been rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Kobylinski (US 6,883,546) in view of Echols (US 5,473,787). Claims 9, 10, 13, 15 and 16 have been

rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Mostala (US 6,755,216).

Applicant has amended independent Claim 1 to include limitations previously recited in dependent claims 2 and 4, has amended independent Claim 8 to include limitations previously recited in dependent Claims 11 and 13, and has further amended independent Claims 1 and 8 to more clearly define over the applied references. Applicant will advance arguments hereinbelow to illustrate the manner in which the presently claimed invention is patentably distinguishable from the cited and applied prior art. Reconsideration of the present application is respectfully requested.

Claims 1, 3, 5 and 6 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Kobylinski (US 6,883,546). Claims 8, 11, 12 and 14 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Mostala (US 6,755,216). However, to anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

The patent to Kobylinski discloses a plug assembly 10 for sealing an opening in the end of a tubular member. Plug assembly 10 is comprised of a capping compression plate 30 having a domed first side 24, a second side 26, an aperture 28, and a locking means 20 integral with the domed first side 24. An elastomeric sealing gasket 40 abuts the second side 26 of compression plate 30. Elastomeric sealing gasket 40 is comprised of a hollow

sleeve 46 and an enlarged flange 42, which faces and abuts the second side 26 of capping compression plate 30. Compression base plate 50 engages sealing gasket 40, and has a borehole 64 with threads 56. Winged, threaded bolt 12 extends through capping compression plate 30, elastomeric sealing gasket 40, with threads 16 on bolt 12 engaging threads 56 in compression base plate borehole 64. Kobylinski does not show 1) a cylindrical main body with a flat bottom surface, with the main body being tapered so that the bottom surface circumference is smaller than the top surface circumference, 2) a compressible alignment portion having a circumference that is less than the circumference of the main body top surface, and is constant throughout the length of the alignment portion, 3) a flat compression plate, and 4) a flat washer disposed around the bottom end of the compression rod between the bottom surface of the main body and the rotatable fastener. Therefore, since each and every feature of Applicant's claimed invention is not shown in the patent to Kobylinski, the rejection of Claims 1, 3, 5 and 6 under 35 U.S.C. § 102(e) is improper and should be withdrawn.

The patent to Mostala discloses a method and apparatus for repairing a leak in a piping system. Plugging tool 46 comprises a main body 70 with top and bottom surfaces, a cylindrical, compressible alignment portion 64, which engages the main body 70, a rigid, flat compression plate 68, which engages the compressible alignment portion 64, an elongate compression rod 60 extending through the center of the main body 70, the alignment portion and the compression plate. Mostala also shows a rotatable fastener 74 secured to the bottom end of the compression rod 60, and a flat washer 72 disposed around the bottom end of the compression rod 60 and located between the main body 70 and

rotatable fastener 74. Pipe coupling 52 is used to repair a pipe leak. Mostala does not show 1) a main body that is tapered, wherein the bottom surface of the main body has a smaller circumference than the circumference of the top surface, 2) a main body top surface circumference configured to equal the outer circumference of a pipe being repaired, and 3) a compressible alignment portion having a circumference less than the circumference of the main body top surface. Therefore, since each and every feature of Applicant's claimed invention is not shown in the patent to Mostala, the rejection of Claims 8, 11, 12 and 14 under 35 U.S.C. § 102(e) is improper and should be withdrawn.

Regarding the rejection of Claims 9, 10, 13 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Mostala, the Examiner believes that it would have been obvious to taper the main body 70 of Mostala because "such is merely a choice of mechanical design to change the shape of the body to be at least partially tapered (Office Action, p. 5, lines 17-18)". Applicant does not agree. It is not seen how the main body 70 of Mostala could be tapered, or what would be gained by such a tapering since wing nut 74 seems to be considerably wider than the diameter of the main body 70 and the main body 70 does not even engage the interior of connection section 48. In any event, Applicant's amended independent claims 1 and 8 require that the main body top surface circumference is configured to equal the outer circumference of a pipe being repaired, and that the compressible alignment portion has circumference that is less than the circumference of the main body top surface. These features are not taught or suggested by Mostala. In this regard, it would not have been obvious to make the circumference of the main body top surface of Mostala greater than the circumference of the of compressible alignment portion

64, since to do so would prevent the device from being used for the purpose intended. If main body 70 had a larger circumference than alignment portion 64, connection section end portion 86 would not fit into socket 41. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). See MPEP§ 2143.01(V). Thus, the rejection under 35 U.S.C. § 103(a) based on Mostala is improper and should be withdrawn.

Dependent Claim 2 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobylinski in view of Mostala. The limitations of Claim 2 are now recited in amended Claim 1. The Examiner believes that it would have been obvious to modify the plug assembly of Kobylinski by providing a flat washer around the bottom end of the compression rod 16, between the bottom surface 24 of the main body 30 and the rotatable fastener 12, as taught by flat washer 72 of Mostala. Applicant does not agree.. In this regard, the flat washer of Mostala could not be placed on the compression rod 16, between the main body 30 and the rotatable fastener 12 as the Examiner proposes, because of the presence of T-shaped locking ear 20 on main body 30. Additionally, Mostala fails to supply other features lacking in the basic reference to Kobylinski noted above. Those features neither taught nor suggest by either Kobylinski or Mostala being a cylindrical main body being tapered so that the bottom surface circumference is smaller than the top surface circumference, and a compressible alignment portion having a circumference that is less than the circumference of the main body top surface and is constant throughout the length of the alignment portion. Since these features are not taught or suggested by Kobylinski and

Mostala, and as noted above the flat washer of Mostala could not be placed on the compression rod of Kobylinski, the rejection under 35 U.S.C. § 103(a) based on Kobylinski in view of Mostala is improper and should be withdrawn.

Dependent Claim 4 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobylinski in view of Provost. Provost discloses a test plug, having a lower plug A, and an upper plug B. Upper plug B has an upper body portion 10, which is frusto-conical in shape or tapered, on top of a lower portion which includes a rubber ring 9. The purpose of the upper tapered portion 10 is so that the center thereof may be moved downward by a force placed thereon by wing nut 22, thereby expanding rubber ring 9 against the interior of the casting. The taper of portion 10 has nothing to do with contacting a pipe outlet as the Examiner recites in his rejection (Office Action, p. 4, lines 5-6). The Examiner believes that it would have been obvious to modify the main body portion 30 of Kobylinski by forming it with a tapered portion as taught by Provost. The Applicant, again, does not agree with the Examiner's conclusion. In this regard, there is clearly no suggestion or incentive in the applied references to Kobylinski and Provost to modify the Kobylinski main body 30 as urged by the Examiner, absent the teachings of Applicant's own disclosure. Applicant admits that many devices have tapered portions, but that doesn't mean that it would have been obvious to modify the Kobylinski patent to included a taper if there is no teaching or suggestion in the prior art to make the modification. The teachings of Provost simply do not suggest to one of ordinary skill in the art to provide a taper on the main body portion of Kobylinski as the Examiner proposes. Additionally, Provost fails to supply other features lacking in the basic reference to Kobylinski noted above. Those features which are

neither taught nor suggested by Kobylinski or Provost being a cylindrical main body with a flat bottom surface, a compressible alignment portion having a circumference that is less than the circumference of the main body top surface and is constant throughout the length of the alignment portion, a flat compression plate, and a flat washer disposed around the bottom end of the compression rod between the bottom surface of the main body and the rotatable fastener. Since these features are not taught or suggested by Kobylinski and Provost, and as noted above the teachings of Provost simply do not suggest to one of ordinary skill in the art to provide a taper on the main body portion of Kobylinski as the Examiner proposes, the rejection under 35 U.S.C. § 103(a) based on Kobylinski in view of Provost is improper and should be withdrawn.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). There is nothing in the teachings of the relied upon prior art references which would have suggested the desirability, and thus the obviousness of the Examiner's modifications of either the lockable compression plug assembly of Kobylinski, or Mostala's method of repairing a leak in a pipe system. Indeed, some of the modifications are not even shown in the teaching references. It is only by impermissible hindsight and reliance on Applicant's own disclosure that the Examiner would have been led to reconstruct the Kobylinski's compression plug or Mostala's method

of pipe repair, so as to derive Applicant's claimed pipe repair tool from the applied teachings. It is therefore Applicant's conclusion that the combined teachings of Kobylinski Mostala and Provost fail to establish a *prima facie* case of obviousness.

The Echols patent relied upon by the Examiner in rejecting dependent claims, and the remaining patents made of record in the application but not applied against any of the claims have also been carefully reviewed, however, Applicant finds nothing therein which would overcome or supply that which is lacking in the basic combinations of the other applied prior art noted above.

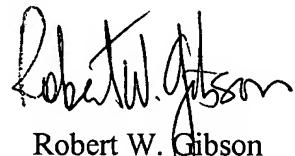
The claims in this application have been revised to more particularly define Applicant's unique construction in view of the prior art of record. Reconsideration of the claims in light of the amendments and for the above-noted reasons is respectfully requested.

*Application No.:10/784,154
Art Unit:3754*

*Attorney Docket No.:21869.01
Confirmation No.:8285*

For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,



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RWG/dht

Attachments: Petition for One-Month Extension of Time,
Check for \$60.00